

REMARKS

Applicant thanks the Examiner for the courtesy extended to Applicant Alexander Medvinsky and Applicant's representative during an interview on September 15, 2006.

During the interview, Applicant discussed Applicant's invention and explained U.S. Pub. 2003/0003896 to Klingler et al. (hereafter "Klingler"). Applicant explained that Applicant would submit a declaration to antedate the Klingler reference. Applicant also directed the Examiner to various parts of Applicant's disclosure which provide written description support for the amendments to claims 1, 17 and 19 made in Applicant's response filed on July 29, 2005. It is Applicant's understanding that the Examiner agreed to consider Applicant's declaration and had no particular objections with the process of antedating the Klingler reference during the interview. It is also Applicant's understanding that the Examiner desired to review the application in further detail regarding the written description support.

I. Introduction

Claims 1-7 and 10-23 are pending in the above application.

Claims 1, 17 and 19 stand rejected under 35 U.S.C. § 112 ¶ 1.

Claims 1-7 and 10-23 stand rejected under 35 U.S.C. § 103.

Claims 1, 6, 13, 17 and 19 are independent claims.

II. Claim Objections

Claims 11, 12, 15, 16, 18 and 21-22 stand objected to for grammatical concerns. Specifically, the Examiner asserts that a comma or appropriate correction should be

inserted in these claims. Applicant has amended these claims to place them in better grammatical form. Applicant further notes that while the Examiner appears to be concerned with alteration of the scope of the claims, Applicant of course is entitled to amend claims in manners that change the scope thereof. Furthermore, the Examiner's apparently espoused interpretation of these claims is not endorsed by Applicant and is both unwarranted and inaccurate at least because it does not appear to properly view the claims as being "open". In any event, it is believed that the present amendments place the claims in better grammatical form, which is believed to be underlying concern of the objection.

III. Rejections Under 35 USC § 112

Claims 1, 17 and 19 stand rejected under 35 U.S.C. § 112 ¶ 1 as allegedly containing subject matter which is "not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention." Office action, pg. 4. Applicant respectfully traverses the rejections.

In further explaining the rejection, the Office action states "Applicant's disclosure fails to recite whether the generating of a new key or the changing of the component occurs during the communication session." Office action, pg. 4. The Office action then invites Applicant to point out support for such in the specification. As discussed in the interview, at least Figure 2 and the description thereof on page 8, line 30 through page 10, line 23 clearly discloses such features. Page 8, lines 32-33 recite "the process for continuing secure voice communication when a CODEC change or SSRC collision

occurs is shown.” Figure 2 further contains decision block 208 which is labeled “CODEC Change” and instruction block 210 which is labeled “Generate New Key Stream” when the result of the decision block 210 is “YES.” Page 9, lines 30-32 recite “a first embodiment of the invention simply generates a new set of keys by re-executing the above key derivation function to start a whole new RC4 key stream when a CODEC change occurs.” Page 10 discusses using both the old CODEC and the new CODEC for a period of time, see page 10, lines 13-16 (“MTA 104 receives the packets with the new CODEC with the new set of keys and may optionally keep the old keys for a short period to receive packets that are still using the old CODEC.”).

Accordingly, the disclosure clearly supports the claimed language and Applicant respectfully requests the rejection to be withdrawn.

IV. Prior Art Rejections

Claims 1-3, 6-7, 10-16 and 19-23 stand rejected under 35 U.S.C. § 103 as being unpatentable over Klinger et al. (U.S. Pub. No. 2003/0003896) in view of Dent (U.S. Pat. No. 5,081,679).

Claims 4 and 5 stand rejected under 35 U.S.C. § 103 as being unpatentable over Klinger in view of Dent and in view of Crichton et al. (U.S. Pub. No. 2002/0031126).

Claims 17 and 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Klinger in view of Crichton in view of Dent.

Klinger was filed on December 19, 2001 and claims priority to provisional application 60/256,668 filed on December 19, 2000. The above application was filed on January 16, 2001, prior to the filing date of Klinger but after the filing date of Klinger’s

provisional application. Accordingly, Klinger only qualifies as prior art to the above application by reliance on its provisional filing date and only under 35 U.S.C. § 102(e).

While Applicant does not concede that Klinger is supported by its provisional, the attached § 1.131 declaration of Alexander Medvinsky, establishes that the invention of the above application was conceived prior to the filing date of the Klinger provisional, i.e., prior to December 19, 2000. Particularly, the attached declaration establishes that the subject matter of the claimed invention of the above application was submitted to the law department of General Instrument Corporation by September 19, 2000. Accordingly, the attached declaration antedates Klinger and removes Klinger as prior art. See, MPEP 715.

As the primary reference, Klinger, has been antedated and is no longer prior art, Klinger also cannot be used in a rejection under 35 U.S.C. § 103. Accordingly, Applicant respectfully requests the above rejection under Klinger in view of Dent to be withdrawn. Furthermore, Applicant respectfully requests the above rejection under Klinger in view of Dent and Crichton to be withdrawn.

B. Applicants again note that all of the above rejections rely on Klinger as § 102(e) prior art to the above application. Crichton is also relied on as § 102(e) prior art. However, neither Klinger nor Crichton clearly qualify as 102(e) prior art. Klinger was filed on December 19, 2001 as U.S. Serial No. 10/028,573 and claims priority to U.S. Provisional application 60/256,668 filed on December 19, 2000. The filing date of Klinger (December 19, 2001) is after the filing date of the above application (January 16, 2001) and the Office action appears to rely on the provisional filing date of Klinger.

Likewise, Crichton was filed on September 12, 2001 as U.S. Serial No. 09/953,317 (after the filing date of the above application) and claims priority to provisional application 60/232,094 filed on September 12, 2000. Applicant respectfully traverses relying on the provisional filing dates of Klinger and Crichton, especially since the utility applications of Klinger and Crichton contain substantially more disclosure including more figures and description, than their provisionals. Since utility applications may and often do contain additional subject matter not disclosed in the provisional, there is simply no logic nor legal foundation for blindly relying a provisional filing date as the 102(e) date of a reference, contrary to the unsupported and unexplained statements in MPEP 706.02(a) and 2136.01. Notably, an applicant who wishes to rely on their own provisional filing date must actually establish that the provisional actually discloses what is claimed, i.e. “conforms to 35 U.S.C. 112, first paragraph”. See MPEP 2136.05. Likewise, a CIP only provides priority and can be used as a reference only for what is actually disclosed in the parent (MPEP 2136.03 IV). Finally, even the USPTO Board, in an unpublished opinion actually reviewed the disclosure of the provisional, which was exactly the same as the utility application, before declaring that the provisional filing date could be relied on as the 102(e) date of the utility application. See, *Ex parte Ushioda*, 2001 Pat. App. LEXIS 106 (October 2001) (copy attached to response). Accordingly, Klinger and Crichton should only be afforded a 102 (e) of their provisionals for what their respective provisionals are shown to disclose by the Examiner, i.e. the burden is on the Examiner to establish the prior art reference dates relied upon in the rejections.

In response to Applicant’s reasonable request for the Examiner to establish that the Klinger provisional actually discloses the features upon which the Examiner cites in

Klinger, the Examiner characterizes Applicant's request as a "general allegation" and requests the Applicant to prove a negative fact - that the Klinger provisional does not disclose Applicant's claimed invention. This is nothing more than a blatant shifting of the Examiner's burden to establish a *prima facie* case onto Applicant to establish a *prima facie* case does not exist. Accordingly, Applicant respectfully objects to this tactic.

In any event, it is not clear if any of the "citations" in Klinger upon which the Examiner relies are disclosed in the Klinger provisional. For example, the Examiner cites paragraph [0026] of Klinger as allegedly containing a "synchronization counter with a size of a message that allows determining when the last block of the message has been transmitted as the counter decrements to zero then initializing the cryptosystem," which is apparently construed to relate to Applicant's claimed voice packets. Office action, pg. 5. This feature does not appear to be contained in the provisional, i.e. the provisional does not discuss packets and the provisional does not discuss instructing a counter to count to zero to initialize a cryptosystem. To the extent the Examiner disagrees, the Examiner is respectfully requested to particularly point out support for such.

V. Conclusion

Having fully responded to the Office action, the application is believed to be in condition for allowance. Should any issues arise that prevent early allowance of the above application, the examiner is invited contact the undersigned to resolve such issues.

To the extent an extension of time is needed for consideration of this response, Applicant hereby requests such extension and the Commissioner is hereby authorized to charge deposit account number 502117 for any fees associated therewith.

Respectfully submitted,

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